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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,071	08/25/2000	David Yinkai Chao		6895

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EXAMINER
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DANG, HUNG XUAN

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/648,071</b>	Applicant(s) <b>Chao</b>
Examiner <b>Hung X. Dang</b>	Art Unit <b>2873</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on May 29, 2002  
2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-4, 6, and 8-30 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-4, 6, and 8-30 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____	6) <input type="checkbox"/> Other: _____

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1. The response filed on 5/15/02 has been entered.

**Claims Rejection Under 35 USC - 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6 and 8-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,737,054) in view of **Chao** (5,568,207).

**Chao** '054 disclose that a primary frame (10) including a first bridge (13), the first bridge (13) including a first magnetic (14), an auxiliary lens frame (20) having a second bridge (21) having an arm (22) extended rearward toward the primary frame (10) and extend over the first bridge (13), the arm including a rear end having a flange (24) extended downward for engaging with the first bridge and for securing the auxiliary frame to the primary frame, the flange (24) including a second magnet for engaging with the first magnet (14) and for securing the auxiliary frame to the primary frame. (See figures 1, 2 and 4

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and the related disclosure) Chao '054 does not disclose that two side of the auxiliary frame each having an extension extended rearward toward the primary frame and extended over one of the studs, the extensions each including a rear end having a first flange extended downward.

Chao '207, however, discloses that two side of the auxiliary frame (20) each having an extension (21) extended rearward toward the primary frame (10) and extended over one of the studs (11), the extensions (21) each including a rear end having a first flange (22) extended downward (please see figure 15).

Because Chao '054 and Chao '207 are both from the same field of endeavor, the purpose of preventing the auxiliary spectacle frame from moving downward relative to the primary frame as disclosed by Chao '207 would have been recognized as an art pertinent art of Chao '054.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the auxiliary lenses for eyeglasses, such as the one disclosed by Chao '054, with two side of the auxiliary frame each having an extension extended rearward toward the primary frame and extended over one of the studs, the extensions each including a rear end having a first flange extended downward,

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such as disclosed by Chao '207 for the purpose of preventing the auxiliary spectacle frame from moving downward relative to the primary frame.

**Claims Rejection Under 35 USC - 103**

3. Claims 1-4, 6 and 8-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,568,207) in view of **Chao** (5,737,054).

Chao '207 discloses auxiliary lenses for eyeglasses which comprising a primary lens frame (10), an auxiliary lens frame (20). The auxiliary lens frame (20) having two magnetic members (22) secure to the arms (21) thereof for engaging with the magnetic members (14) of the primary lens frame (10) for securing the auxiliary lens frame (20) to the primary lens frame (10). Chao '207 does not disclose that the bridge of the auxiliary lens frame having an arm extended over the bridge of the primary lens frame for securing the auxiliary lens frame to the primary lens frame.

Chao '054 disclose that the auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a

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magnetic connector member for engaging with the connector member of the primary lens frame.

Because Chao '207 and Chao '054 are both from the same field of endeavor, the purpose of providing auxiliary lens frame which may be easily engaged on the primary lens frame as disclosed by Chao '054 would have been recognized as an art pertinent art of Chao '207.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the auxiliary lenses for eyeglasses, such as the one disclosed by Chao '207, with auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a magnetic connector member for engaging with the connector member of the primary lens frame, such as disclosed by Chao '054 for the purpose of auxiliary lens frame which may be easily engaged on the primary lens frame.

**Claims Rejection, Obviousness Double Patenting**

**4.** The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by

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a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4, 6 and 8-30 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,109,747. Although the conflicting claims are not identical, they are not patentably distinct from each other because claimed invention in claims 1-4, 6 and 8-30 of this application is substantially the same as that in claims of the U.S. Patent No. 6,109,747. All the limitations in claims 1-4, 6 and 8-30 of this application is included in the U.S. Patent No. 6,109,747 and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention

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in claims 1-4, 6 and 8-30 of this application is substantially identical to that of claims in the U.S. Patent No. 6,109,747. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Applicant's arguments filed 5/15/02 have been fully considered but they are not persuasive.

Applicant argued that: "Neither of Chao' 207 or the Chao' 054 references teach or suggest the combination, and the office action does not provide an explanation of how the skilled artisan would be motivated to combine the modified the teaching of Chao' 207 with Chao' 504."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the

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art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the purpose of providing auxiliary lens frame which may be easily engaged on the primary lens frame as disclosed by Chao '054 would have been recognized as an art pertinent art of Chao '207.

7. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.

8/02



HUNG DANG

PRIMARY EXAMINER

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